

**REMARKS**

This Amendment is prepared in response to the second, non-final Office action mailed on 22 February 2007 (Paper No. 20070212). Upon entry of this amendment, claims 1 and 3 through 34 will be pending. Applicant has canceled claim 2 without prejudice or disclaimer as to its subject matter and newly added claim 34 by this amendment.

**Claim Rejections under 35 U.S.C. §112, second paragraph**

On Page 2 of Paper No. 20070212, the Examiner persisted in his rejection of claims 7, 9, 14, 15 19-22 and 27 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In an Amendment filed on December 19, 2006, Applicant traversed this rejection. On Page 6 of Paper No. 20070212, the Examiner responded to Applicant's December 19 traversal by saying, "then phrases "less than", "not to exceed" render the claims indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP 2173.05 (d). Therefore, the rejection needs to be addressed." Applicant has the following comments:

MPEP 2173.05 (d) states:

**“2173.05(d) Exemplary Claim Language ("for example," "such as") [R-1]**

Description of examples or preferences is properly set forth in the specification rather than the claims. If stated in the claims, examples and preferences >may< lead to confusion over the intended scope of a claim. In those instances where it is not clear whether the claimed narrower range is a limitation, a rejection under 35 U.S.C. 112, second paragraph should be made. The examiner should analyze whether the metes and bounds of the claim are clearly set forth. Examples of claim language which have been held to be indefinite because the intended scope of the claim was unclear are:

(A) "R is halogen, for example, chlorine";

(B) "material such as rock wool or asbestos" *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1949);

(C) "lighter hydrocarbons, such, for example, as the vapors or gas produced" *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949); and

(D) "normal operating conditions such as while in the container of a proportioner" *Ex parte Steigerwald*, 131 USPQ 74 (Bd. App. 1961).

>The above examples of claim language which have been held to be indefinite are fact specific and should not be applied as *per se* rules. See MPEP § 2173.02 for guidance regarding when it is appropriate to make a rejection under 35 U.S.C. 112, second paragraph.”

Applicant submits that MPEP 2173.05 (d) does not pertain to Applicant’s claims. MPEP 2173.05 (d) states that preferences and examples belong in the specification and not the claims. MPEP 2173.05 (d) indicates that preferences or examples are indicated by words such as “for example” or “such as”. Applicant submits that Applicant’s claims do not contain the phrases preferences or examples and Applicant’s claims do not contain the phrases “for example” or “such as” or any other comparable phrase that would indicate an example or preference should not be given patentable weight. Because Applicant’s claims do not include the phrases “for example” or “such

as” or any other language that would indicate a preference or example, Applicant submits that Applicant’s claimed limitations are proper limiting limitations. Because of this, Applicant submits that MPEP 2173.05 (d) is inapplicable to Applicant’s claims. Because of this, Applicant submits that there is no proper basis for the 35 U.S.C. 112, second paragraph rejections of Paper No. 20070212.

### **Prior Art Rejections**

In Paper No. 20070212, the Examiner rejected claims 1-31 under 35 U.S.C. §103(a) as being unpatentable over Ohara *et al.* (US 6,356,626) in view of Johnson *et al.* (US 6,356,626), but applied newly cited Nozaki (USP 6,421,470) instead of Johnson. Applicant assumes that claims 1 through 31 are rejected in Paper No. 20070212 using Ohara in view of Nozaki. Applicant has the following comments:

Applicant’s invention pertain to a mailable postcard with a vinyl exterior and foam therebetween and a circuit board therebetween, the circuit board having an EEPROM storing an audio message, a speaker to allow the recipient to hear the message, a pair of batteries, a playback button and a voice synthesizer chip. The postcard can fit on a small stand which serves to record a message onto the postcard. The recording stand is powered by the batteries within the postcard.

Ohara, and in particular, FIG. 6 of Ohara, discloses a voice message recording/playback

device. A direct record input device 24 can attach to a playback unit 22 for sending audio messages. Ohara lacks a teaching of a postcard and lacks a teaching of vinyl and foam found in Applicant's postcard. For this, the Examiner in Paper No. 20070212 turns to Nozaki, and in particular, FIG. 12 of Nozaki.

Nozaki discloses an image and audio processing apparatus. Nozaki discloses how images and audio can be saved and linked together for output. In Nozaki, saved images are linked to saved audio recordings. FIG. 12 illustrates that the image can be printed onto a postcard. The corresponding (or linked) audio information can be attached to the image bearing postcard by attaching an audio code image strip 7. When the audio code image 7 is scanned with a scanner 8, the audio message can be output through a speaker in the scanner 8 (see col 5, lines 55-67 and col 15, lines 32-38 of Nozaki). The scanner 8 containing the speaker is separate from the postcard. The postcard in Nozaki does not contain a speaker, a battery, a play button or a voice synthesizer as these are in the scanner 8 of Nozaki. Furthermore, there is no indication in Nozaki that the postcard has a vinyl exterior or foam therebetween.

On Page 4 of Paper No. 20070212, the Examiner indicates that Ohara as modified by Nozaki would result in Applicant's claimed invention by saying, "it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Ohara using the teaching of greeting postcard as taught by Nozaki. This modification of the invention enables the system to send a postcard so that the user would receive the greeting postcard by mail."

Applicant disagrees. Applicant submits that Ohara as modified by Nozaki would not fairly result in Applicant's claimed invention.

To begin with, Applicant submits that there is no proper motivation to turn to Nozaki to fill in for the deficiencies of Ohara. This is because Nozaki, like Ohara already contains an audio storage, recording and playback apparatus. Because Nozaki already has an audio recording, storage and playback apparatus, there is no justifiable reason why one having ordinary skill in the art would want to turn to Nozaki to fill in for the deficiencies of Ohara.

Applicant further submits that even if Ohara and Nozaki were combinable, Ohara as modified according to Nozaki would not result in Applicant's claimed invention. This is because if Ohara were to be modified according to Nozaki, the resultant would be an image bearing postcard as in FIGS. 12 and 19 of Nozaki with an audio code image 7 attached thereto. Such a structure could not read on Applicant's claims as Applicant claims that the postcard comprises a speaker, a pair of batteries, a playback button and a voice synthesizer. In Ohara as modified according to Nozaki, the speaker, the batteries, the playback button and the voice synthesizer would not be on the postcard but on the scanner (see col 5, lines 60-67, col 15 lines 35-38 and FIGS. 2 and 19 of Nozaki, for example). Because Ohara as modified according to Nozaki would not have the speaker, the batteries, the playback button and the voice synthesizer on the postcard but instead on the scanner 8-separated from the postcard, and because Applicant claims that the speaker, the batteries, the playback button and the voice synthesizer reside within the postcard, Ohara as modified according

to Nozaki does not reasonably teach or suggest Applicant's claimed invention.

In Paper No. 20070212, the Examiner is taking the teachings of Ohara, and using Nozaki only for the teaching of a postcard. Applicant submits that the Examiner is ignoring other features of Nozaki that could or would teach away from Applicant's claimed invention, such as the fact that Nozaki does not have a speaker, a battery, a voice synthesizer or a playback button on the postcard but instead relegates the speaker and battery to the scanner 8 physically separated from the postcard. Applicant submits that the prior art rejections of Paper No. 20070212 are the product of impermissible hindsight reconstruction where the Examiner is using Applicant's claims as a blueprint to pick and choose different features from each of Ohara and Nozaki to arrive at Applicant's claimed invention. This is not supposed to be what is done during examination. Instead, during examination, the Examiner must determine from the references themselves what the two references of Ohara and Nozaki as a whole would teach, and in doing so, to consider teachings in Ohara and Nozaki that may teach away from Applicant's claimed invention. The Examiner did not do this in Paper No. 20070212. And this is evidenced by the fact that the Examiner never justified why Ohara is modified only by the postcard feature of Nozaki and not by the scanner 8 and audio code image strip 7 features of Nozaki.

Applicant's above comments apply both to Applicant's independent apparatus claims as well as Applicant's depending method claims. Applicant submits that for similar reasons, Ohara as modified according to Nozaki does not fairly teach the method of Applicant's claim 9, for example.

Applicant claims a recording device onto which the postcard is inserted into for recording. Applicant can not find any comparable recording device in either of Ohara or Nozaki into which it can be fairly said that the postcard of Nozaki can be fitted into for recording thereon.

**Not only does the combination of Ohara in view of Nozaki not fairly teach or suggest Applicant's claimed invention at large, but there are numerous features in Applicant's claims that are not found in either Ohara or Nozaki. Applicant will now discuss these features.**

**Regarding Applicant's claims 32 and 33,** Applicant claims in claim 32 that the postcard contains "a pair of vinyl layers, one being on each side of the postcard, the vinyl layers being adapted to allow a user to write a message thereon; and foam arranged on portions of a space between the vinyl layers absent the PCB" and in claim 33, "the postcard further comprising a foam layer arranged within the postcard underneath the vinyl in portions absent said PCB". On Page 6 of Paper No. 20070212, the Examiner addresses these limitations by saying they are taught by col 12, lines 19-35 of Nozaki. Col 12, lines 19-35 of Nozaki state:

"FIG. 12 shows new year's greetings postcards with a photograph as an example of audio-coded recording media printed out. FIG. 12(a) shows the back of a new year's greetings postcard with an audio code image 7 disposed in a blank region not recording the photograph or characters. FIG. 12(b) shows the back of a new year's greetings postcard with an audio code image 7 disposed in a masking region formed with a white undercoat seal in a visual image recording region where the photograph and characters are recorded. FIG. 12(c) shows the front of a new year's greetings postcard with an audio code image 7 printed above the new year's gift number, visual images such as the photograph and characters being printed on the back. For this purpose, the visual/audio code image layout editor 234 and visual/audio code image synthesizer 246 have also functions to develop the visual

and audio code images on a plurality of printing sheets.”

Applicant submits that this passage, as well as the entire reference to Nozaki, are clearly silent regarding either “vinyl” or “foam”. Because neither O’Hara nor Nozaki teach or suggest vinyl or foam in a postcard, the rejection of Applicant’s claims 32 and 33 are without merit.

**Regarding Applicant’s claims 4, 17 and 26**, Applicant claims an EEPROM. On Page 5 of Paper No. 20070212, the Examiner states, “Regarding claim(s) 4 and 17, Ohara discloses a system, said memory comprising an EEPROM being automatically overwritten by a subsequently recorded message (col 13, lines 17-35).” Applicant disagrees. Applicant has reviewed the entire reference to Ohara, including col 13, lines 17-35 of Ohara, and can find no evidence or mention of an EEPROM. Because neither Ohara nor Nozaki teach an EEPROM, Applicant submits that the rejection of claims 4, 17 and 26 in Paper No. 20070212 are without merit.

**Regarding Applicant’s claims 16, 23, 30 and 31**, Applicant claims that the postcard is covered with vinyl enabling a user to write thereon. Applicant has reviewed each of Ohara and Nozaki and can not find any evidence of vinyl siding for a postcard. Therefore, Applicant submits that Ohara in view of Nozaki can not possibly teach Applicant’s claims 16, 23, 30 and 31.

**Regarding Applicant’s claim 29**, Applicant claims a pair of 3 volt Lithium Ion batteries. In Paper No. 20070212, although the Examiner refers to claim 29, Applicant submits that the Examiner never addressed this limitation in Paper No. 20070212. Further, Applicant has reviewed



Ohara and Nozaki and can not find any evidence of a pair of 3 volt Lithium Ion batteries in either of these two references. Therefore, Applicant submits that the rejection of claim 29 in Paper No. 20070212 is unwarranted.

**Regarding Applicant's claim 9**, Applicant claims "inserting said postcard ... into a slot of a recording unit ...". Applicant submits that this limitation was never addressed in Paper No. 20070212. Applicant objects as this is evidence of an incomplete Office action. Applicant further submits that if Ohara were to be modified according to Nozaki, Applicant's claim 9 would not result. This is because Nozaki does not teach placing the postcard of FIGS. 2, 12 or 19 into a slot of a recording device. Instead, Nozaki merely teaches printing an image on a postcard and attaching an audio code image strip 7 to the postcard as there is no part in Nozaki that corresponds to Applicant's recording unit.

**Regarding Applicant's claims 1, 6, 14, 24**, Applicant claims that the recording unit is powered by the postcard. In Paper No. 20070212, the Examiner states that this is taught by col 13, lines 17-35 of Ohara. Applicant disagrees. First, Ohara does not teach a postcard, only Nozaki does. Second, there is no power supply within the postcards of Nozaki. Therefore, Ohara as modified according to Nozaki can not fairly teach or suggest Applicant's claims 1, 6, 14 and 24.

Applicant has canceled claim 2 and moved it to newly added claim 34 to correct for an antecedent basis error.

A fee of \$60.00 is incurred for a one-month extension of time for a small entity set to expire on June 22, 2007. Applicant's check drawn to the order of Commissioner accompanies this Amendment. Should the check become lost, be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

In view of the above, it is requested that the election requirement be withdrawn. It is further submitted that the application is in condition for examination on the merits, and early allowance is requested. No other issues remaining, reconsideration and favorable action upon all of the claims now present in the application is respectfully requested.

Respectfully submitted,



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